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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/807,664	07/05/2001	Wolfgang Becker	113624PCT/US	2217

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EXAMINER

HOWARD, JACQUELINE V

ART UNIT	PAPER NUMBER
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1764

DATE MAILED: 04/22/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/807,664

Applicant(s)

BECKER ET AL.

Examiner

Jacqueline V. Howard

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Claims 11 to 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Becker et al (5,439,709) for the reasons of record as fully set forth in the Office Action dated September 6, 2002.

Applicant's arguments filed February 8, 2003 have been fully considered but they are not persuasive. Applicants traverse the rejection of the claims as being obvious in view of Becker et al and point out the three criteria that must be satisfied to establish a prima facie case of obviousness.

The examiner is well aware of the criteria for establishing a case of prima facie obviousness and maintains the position that the claimed invention would be prima facie obvious in view of the cited prior art

In the first place, applicants argue that the claimed invention comprises a mixture "consisting essentially of". The examiner could not find this language in any claims. Applicants should state specifically where it is found in the specification and claims.

Also, applicants argue that Becker discloses fatty acid methyl esters based on C8-22 fatty acids of various natural origins and provides no distinction between animal-base fatty acids and vegetable-based fatty acids. It is the examiner's position that the fact that patentee did not restrict his fatty acid to vegetable based fatty acids does not negate the fact that he taught them. Of the fatty acid based methyl esters taught at col. 1, line 60 to 62, only one is animal based. The other five are vegetable based. There is no teaching of a preferred fatty acid methyl ester. The examiner does not modify the teaching of the reference. There would be no need to modify the teachings of Becker since he specifically teaches vegetable-based fatty acid methyl esters.

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While Becker exemplifies animal-based fatty acids, references are not used just for what is in the illustrative examples but what is realistically taught in the specification.

The examiner also takes the position that the issue is not whether use of vegetable based esters exhibit unexpected results as compared with animal based esters. The issue is whether Becker teaches a process for lubricating wool wherein a lubricant composition comprising a mixture of C₆₋₂₂ fatty acid methyl esters based on vegetable fatty acids is contacted with wool fibers. Patentee performs such a process. It is not obvious to follow the teachings of the prior art.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to J. V. Howard at telephone number (703) 308-2514.

J. Howard/dh

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